

REMARKS

Claims 1 to 100 were pending in the application at the time of the advisory action. Claims 1 to 100 remain provisionally rejected for obviousness-type double patenting. Claims 1 to 100 remain rejected as anticipated.

Applicant's Attorney acknowledges a telephonic interview with the Examiner in which the statement "The newly presented arguments need to be considered" in the Advisory Action was discussed. Each of the provisional obviousness-type double patenting rejections and the anticipation rejection were discussed, but no agreement was reached.

Claims 1, 10, 15, 20, 29, 34, 39, 48, 53, 58, 75, and 88 are amended to more clearly recite the source and receiver of actions processed by the user device and so more clearly define the invention. The amendments are supported at least by Figs. 52 to 57 and the description thereof.

Claim 9 is amended to correct a grammatical informality.

Provisional Double Patenting Rejection in View of U.S. Patent Application Serial No. 10/687,488 (the '488 application).

Enclosed herewith is a Terminal Disclaimer to Obviate A Provisional Double Patenting Rejection Over U.S. Patent Application Serial No. 10/687,488. Also, enclosed is the appropriate fee. Accordingly, Applicant respectfully submits that the Provisional Double Patenting Rejection in View of U.S. Patent Application Serial No. 10/687,488 is rendered moot. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the obviousness-type double patenting rejection in view of the '488 application.

Provisional Double Patenting Rejection in View of U.S.
Patent Application Serial No. 10/687,459 (the
'459 application).

The rejection stated in part "The subject matter in the instant application is fully claimed in the reference copending application and would be covered by any patent that granted on that copending application."

Applicant respectfully continues to traverse the provisional obviousness-type double patenting rejection. A person practicing the claims of the instant application does not infringe the claims of the '459 patent and conversely. In addition, when the claims in the '459 patent are modified to read on the claims in the instant application, the invention of the '459 patent would no longer work for its intended purpose. Accordingly, MPEP § 2143.01 V., 8th Ed., Rev. 5, p. 2100-129 (August 2006) indicates that the obviousness rejection is not well founded.

Specifically, each of the independent claims in the '459 application includes a limitation similar to

receiving a new authenticated rights locker access request and a Web page with one or more clickable links in response to said sending

None of the claims in the instant application recite receiving two elements and in particular receiving a Web page. Accordingly, the Web page must be eliminated from the claims of the '459 application to arrive at the limitation in claims of the instant application.

However, the remaining elements in claims of the '459 application recite:

receiving an indication of a user selection of one of said one or more clickable links;
sending an authenticated digital content request associated with said one of said one or more clickable links to a digital content repository;

When the Web page is eliminated to make the claims of the '459 application read on the limitation in the claims in the instant application, the clickable links are also removed. Accordingly, neither the receiving nor the sending operations of the claims in the '459 application would work, because no clickable links are available. Accordingly, MPEP states

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

MPEP § 2143.01 at pg. 2100-129. It has been demonstrated that the proposed modification, elimination of the Web page from the claims in the '459 application, would render the invention in the claims of the '459 application unsatisfactory for its intended purpose. Consequently, the provisional obviousness-type double patenting rejection is not well founded. Applicant respectfully requests reconsideration and withdrawal of the provisional double-patenting rejection in view of U.S. Patent Application Serial No. 10/687,459.

§ 102 Rejections

Claims 1 to 100 remain rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application Publication No. 2004/0024652, hereinafter referred to as Buhse. Again, the rejection fails to consistently identify in Buhse what is considered a user device and then demonstrate that each of the processes cited in the Claims are performed on that device. Rather, as demonstrated below, the rejection takes pieces from various elements of Buhse, which are not described by Buhse as a user device and then recombines the disparate elements to read on Applicant's inventions. This is an improper level of analysis for an anticipation rejection.

The MPEP is unequivocal that this level of analysis cannot support an anticipation rejection. The MPEP directs:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." . . . < "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

MPEP § 2131, 8th Ed., Rev. 5, p. 2100-67 (August 2006). It is noted that this directive stated the claim element "must be" shown in as complete detail and arranged as required by the claim. This is not a permissive standard, but rather one that the rejection is required to comply with.

The anticipation standard in the MPEP does not permit extraction of teachings of different elements of Buhse, e.g., from the OMS, RLC and AMC, and recombining and redefining the actions performed by those elements, because such a modification violates the "arranged as required by the claim" requirement. Also, the MPEP anticipation standard does not permit ignoring explicit claim limitations, which violates the "in as complete detail as is contained in the claim" requirement.

Applicant respectfully traverses the anticipation rejection of Claims 1, 20, 39 and 58. Paragraphs [0173] to [0190] of Buhse are cited in the rejection as teaching exactly a user device. This portion of Buhse describes an "Order Management System (OMS)." Therefore, to teach the same invention as recited in Claims 1, 20, 39 and 58, the order management system of Buhse must perform each of the processes recited in Claims 1, 20, 39 and 58. Moreover,

this interpretation of a user device is not supported by any express teaching in Buhse.

The rejection also cited Paragraphs [0160] to [0172] of Buhse as teaching "determining, on said user device, enrollment authentication data." These paragraphs do not describe any action taken on the OMS, which was identified as the user device. These paragraphs describe actions by a rights locker component (RLC) and not actions by the OMS. Thus, the definition of the user device has changed from one claim element to the next. Moreover, these sections do not describe "enrollment authentication data" or determining such data. The RLC is described as processing requests from other components, i.e., a create request, an account update request, and rights information request. Such requests fail to suggest or teach anything concerning enrollment authentication data or the determination of such data. Applicant respectfully continues to submit that the rejection simply finds some elements with names similar to elements in the claims and then mixes and matches these elements from Buhse.

The claims relate elements in the different processes by using "said" or "the," so that the same element is being referred to in the different processes. Further, the elements relied upon in Buhse demonstrate that Buhse fails to teach the claimed inventions in the same level of details as recited in the claims.

Moreover, Buhse shows that the pieces selected are on a system that is separate and distinct from the user devices as illustrated in Fig. 1A of Buhse. Thus, Buhse teaches away from Applicant's invention as recited in each of Claims 1, 20, 39 and 58 that recite a user device and structure and operations on such a device. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 1, 20, 39 and 58.

Applicant respectfully traverses the anticipation rejection of each of Claims 2 to 9, 21 to 28, 40 to 47, and 59 to 74. Each of these claims distinguishes over Buhse at

least for the same reasons as the independent claim from which it depends. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 2 to 9, 21 to 28, 40 to 47, and 59 to 74.

Applicant respectfully traverses the anticipation rejection of each of Claims 10, 29, 48 and 75. Again Paragraphs [0173] to [0190] of Buhse are cited in the rejection as teaching exactly a user device, i.e., "on a user device (pars. 173-190)," as recited in these claims. This portion of Buhse describes an "Order Management System (OMS)." The OMS does not have the relationship to the other elements as recited in these claims. Therefore, the OMS cannot teach the same invention as recited in Claims 10, 29, 48 and 75. The order management system of Buhse does not perform each of the processes recited in Claims 10, 29, 48 and 75. Moreover, this interpretation of a user device is not supported by any express teaching in Buhse. Buhse refers to user devices as communications from a consumer.

The OMS and RLC as described in paragraphs [0154] to [0158] and [0173] to [0188] are cited as determining the digital content specification and the associated authenticated rights locker access request. These sections of Buhse fail to describe a digital content specification. Since these sections of Buhse fail to consider a digital content specification, these sections cannot describe any authenticated rights locker access request associated with such a specification. This alone is sufficient to overcome the anticipation rejection.

The above quotations from the MPEP are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 10, 29, 48 and 75.

Applicant respectfully traverses the anticipation rejection of each of Claims 11 to 14, 30 to 33, 49 to 52, and 76 to 87. Each of these claims distinguishes over

Buhse at least for the same reasons as the independent claim from which it depends. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 11 to 14, 30 to 33, 49 to 52, and 76 to 87.

With respect to Claims 15, 34, 53 and 88, the rejection cited yet again paragraphs [0173] to [0190] [0154] to [0158] and [0123] to [0135]. Applicant respectfully traverses the anticipation rejection of Claims 15, 34, 53 and 88. The above comments with respect to Claims 10, 29, 48 and 75 are directly applicable to these claims also and will not be repeated, but are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 15, 34, 53 and 88.

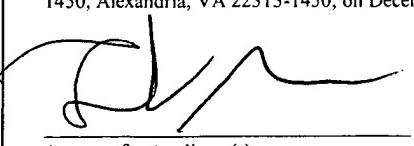
Applicant respectfully traverses the anticipation rejection of each of Claims 16 to 19, 35 to 38, 54 to 57, and 89 to 100. Each of these claims distinguishes over Buhse at least for the same reasons as the independent claim from which it depends. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 16 to 19, 35 to 38, 54 to 57, and 89 to 100.

Claims 1 to 100 remain in the application. Claims 1, 9, 10, 15, 20, 29, 34, 39, 48, 53, 58, 75, and 88 are amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 14, 2007.

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